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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER THERIAULT, STEVEN B				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/623,339

Applicant(s)

BEAMAN, ALEXANDER B.

Examiner

STEVEN B. THERIAULT

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 20-22, 26-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 20-22, 26-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date 01/28/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the following communications: RCE filed 1/28/2009.
2. Claims 1 -15, 20- 22, 26- 35 are pending in the case. Claims 1, 8, 16, 17, 20, 21, and 26 are the independent claims. Claims 33-35 are new. Claims 16-19 and 23-25 have been cancelled

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 01/28/2009 has been entered.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 35 and 36 been renumbered 34 and 35 as it appears claim 34 has been skipped.

Response to Amendment

3. The Affidavit filed on 1/28/2009 under 37 CFR 1.131 is sufficient to overcome the Born reference. In conjunction with the previous affidavit filed 10/11/2007 the evidence in the record points to conception and diligence on the part of applicant's representative to the effective date of March 3, 2003 based on the submitted inventor's disclosure document. However, applicant has amended the claims to address the prior art and based on an updated search to address the amended features a new ground of rejection is presented below.

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4. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-2, 4, 8-15, 20, 33-35 are rejected under 35 U.S.C 102(e) as being anticipated by Bulthuis et al. (hereinafter Bulthuis) U.S. Patent No. 6978127 filed Dec. 16, 1999.**

In regard to **Independent claim 1**, Bulthuis teaches a method for providing an audio menu, comprising:

- Providing text strings on a server, each text string capable of representing a audible menu choice (See Bulthuis column 2, lines 45-67 and column 3, lines 20-50 and column 4, lines 45-55 and column 67, lines 57-67 and column 7, lines 5-67, See “selected string” column 3). Bulthuis teaches providing title, genre and music information that can be downloaded to the device as a menu choice form a virtual jukebox.
- Generating audio files, each audio file representing a voiced name of one of the text strings (See column 2, lines 45-67 and column 3, lines 20-50 and column 4, lines 45-55 and column 67, lines 57-67 and column 7, lines 5-67). Bulthuis teaches the audio files are stored in memory and audibly rendered to the user.
- Associating each of the audio files with the text string corresponding thereto (See column 2, lines 45-67 and column 3, lines 20-50 and column 4, lines 45-55 and column 67, lines 57-67 and column 7, lines 5-67). The text strings are used to audibly communicate to the user the selections on the phone without the user looking at it.
- Delivering the audio files to a client from the server (See column 7, lines 5-67).
- Presenting a navigable menu on the client that includes menu choices represented by the voice names corresponding to the menu choice, the menu choices being capable of

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being highlighted or selected (See Bulthuis column 2, lines 45-67 and column 3, lines 20-50 and column 4, lines 45-55 and column 67, lines 57-67 and column 7, lines 5-67).

Bulthuis specifically teaches a rotateable wheel that reads aloud the menu choices as the user scrolls through each one. The options are capable of selection when the user clicks the wheel. For example, the user can listen to an audio file list and play the audio file when they hear the option they want (See column 7, lines 35-50).

- Playing the audio file on the client when the associated menu choice is highlighted such that a user can navigate the menu without having to see a visual display on which the menu is displayed (See Bulthuis column 2, lines 45-67 and column 3, lines 20-50 and column 4, lines 45-55 and column 67, lines 57-67 and column 7, lines 5-67) Bulthuis specifically teaches the feedback is presented to the user so that they do not have to look at the device (See column 1, lines 44-55).

With respect to **dependent claim 2**, Bulthuis teaches the method further comprising providing a remote control that can navigate through the menu on the client (See column 9, lines 1-26).

With respect to **dependent claim 4**, Bulthuis teaches the method wherein: the client is capable of playing music; and playing the audio file when music is playing does not stop the music from playing (See column 7, lines 35-55)

In regard to **Independent claim 8**, Born teaches a method for creating audible menu components, wherein the audio menu components represent navigational components directed to the selection of media content on a client device wherein the navigational components provide for the selection of media content without the user seeing a display on which the navigational components are display. (See column 1, lines 45-67). comprising:

- Providing a text string that represents a menu component, whereby the menu component is one of several options that can be selected without the user viewing

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the displayed menu on the client device (See Bulthuis column 1, lines 45-67, column 2, lines 45-67 and column 3, lines 20-50 and column 4, lines 45-55 and column 67, lines 57-67 and column 7, lines 5-67) Bulthuis teaches audible outputting menu choices to the user, without having to look at the device and the menu has several options.

- Generating an audio file that is an audio representation of the menu component; delivering the audio file to a client device and navigating the audible menu without viewing the displayed menu(See Bulthuis column 1, lines 45-67, column 2, lines 45-67 and column 3, lines 20-50 and column 4, lines 45-55 and column 67, lines 57-67 and column 7, lines 5-67) Bulthuis teaches sending audio files from a server to the device and categorizing the menu options and providing the options to allow the user to select the item.

With respect to **dependent claim 9**, Bulthuis teaches the method further comprising: playing the audio file; and requesting approval of the played audio file prior to delivering the audio file to a client device (See column 7, lines 5-67). The user can choose the items that they want to download from the jukebox.

With respect to **dependent claim 10**, Bulthuis teaches the method wherein generating the audio file is accomplished via a text-to-speech algorithm (See column 10, lines 7-25).

With respect to **dependent claim 11**, Bulthuis teaches the method wherein if approval is not given, providing an opportunity to modify the text string; and if the text string is modified, replacing the audio file with a new audio file generated from the modified text string, playing the audio file, and requesting approval of the played audio file (See column 3, lines 50-67).

With respect to **dependent claim 12**, Bulthuis teaches the method wherein if the text string is not modified, providing an opportunity to replace the audio file with a new audio file generated from an audio recording (column 3, lines 30-67 and column 4, lines 1-60).

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With respect to **dependent claim 13**, Bulthuis teaches the method wherein the audio file generation includes at least compression of the audio file (column 3, lines 30-67 and column 4, lines 1-60 and column 8, lines 1-17).

With respect to **dependent claim 14**, Bulthuis teaches the method wherein the delivery of the audio files includes embedding the audio files in metadata (See column 7, lines 14-30).

With respect to **dependent claim 15**, Bulthuis teaches the method further comprising determining whether the audio file is present on the client device; wherein, delivering the audio files is performed only if the audio file is not present on the client device (See column 7, lines 55-67)

In regard to **Independent claim 20**, claim 20 reflects the device comprising computer readable instructions for performing the steps of method claim 1, and in further view of the following is rejected along the same rationale. Bulthuis teaches a client device (See figure 1, and a memory 108 and a processor 116) that also has a music play out part that has memory 302 to allow the user to select menu items that correspond to display options (See column 7, lines 5-67).

With respect to **dependent claim 33**, Bulthuis teaches the device wherein the client device is in communication with a server comprising:
a processor; and memory, operably connected with the processor; wherein the processor is operable to perform instructions including providing the text string that represents the menu component, wherein the audible menu components representing the navigational components directed to the selection of media content; generating the audio file that is the audio representation of the menu component; delivering the audio files to the client device. See column 2, lines 45-67 and column 3, lines 20-50 and column 4, lines 45-55 and column 67, lines 57-67 and column 7, lines 5-67 and figure 3, memory, processor and device).

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With respect to **dependent claim 34**, Bulthuis teaches the device wherein: the menu includes menu components that have not been received; and pre-packaged audio files are associated with the menu components that have not been received (See column 7, lines 45-67).

With respect to **dependent claim 35**, Bulthuis teaches the device wherein: the audio file is played only after the menu component has been highlighted for a predetermined period of time (See column 7, lines 5-67).

Claim Rejections - 35 USC § 103

6. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bulthuis et al. (hereinafter Bulthuis) U.S. Patent No. 6978127 filed Dec. 16, 1999, in view of Gallenson et al (hereinafter Gallenson) WO 01/30046 International Publication Date 26 April 2001.**

With respect to **dependent claim 3**, as indicated in the above discussion, Bulthuis teaches each element of claim 1.

Bulthuis does not expressly teach the method wherein the voiced names are in a language other than English.

However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Gallenson, because Gallenson teaches a streaming content system that can deliver audio content to a device where the device can determine from the users profile the dialect and language of the user and adapt the system to match the content to the user (See page 17, lines 1-12). Gallenson and Bulthuis are analogous art because they both provide access to content through a menu system in a portable device and they both teach using voice portals and a web server to communicate information to the device. The skilled artisan having the teachings of Gallenson and Bulthuis in front of them, would determine from the suggestions in Gallenson to that the system of Born could be modified to provide content to users in different languages because the system tracks users selections and modifies the content appropriately (See page 15, middle) to meet the users needs.

8. **Claims 5-7 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bulthuis et al. (hereinafter Bulthuis) U.S. Patent No. 6978127 filed Dec. 16, 1999, in view of Swanson et al (hereinafter Swanson) U.S. Publication 20020013784 published Jan. 2002.**

With respect to **dependent claims 5-7 and 30-32**, as indicated in the above discussion, Bulthuis teaches each element of claims 4 and 26.

Bulthuis does teach a headset with left and right attachments (See figure 2) and an audio prompt mechanism that provides a mechanism for audio to be heard via a channel.

Bulthuis does not expressly teach *the method wherein the client produces audio output in at least two channels; and the audio file is output through only one channel and wherein exactly two channels are used for the client's audio output, the two channels being a left channel and a right*

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channel and wherein the audio file is mixed with the music when the music is playing.

However, Swanson teaches a system that allows for a audio player complete with voice menu prompts to play audio files where there are multiple channels of the device and audio is sent over one channel and the user can interact with the device on another (Such as speaking to the device while the music is playing) (See Para 0063-0069). Swanson also teaches mixing the audio file while the music is playing (See Para 0090).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Swanson and Bulthuis in front of them, to modify the system of Bulthuis to include the multiple channels to play audio and a mechanism to mix the audio file menus while the user is listening to the music. The motivation to combine Swanson with Bulthuis comes from the suggestion in Swanson to store and playback audio files on a device where the playback allows for the music to be played and continue to be played even though a user receives an email (See Para 0031). Further, Swanson teaches that the circuitry associated with playing the audio files is used with synthesized voice commands that control the operations of the headset and therefore providing the messages when the music is still playing giving them the option to answer it or not (See Para 0039).

Claims 21-22, 26-29 are rejected under 35 U.S.C 103(a) as being anticipated by Bulthuis et al. (hereinafter Bulthuis) U.S. Patent No. 6978127 filed Dec. 16, 1999, in view of incorporated by reference patent No. 6563769 to Van Der Meulen filed June 4, 1999.

With respect to **dependent claim 21**, Bulthuis teaches the device

- A media database that stores media files (See Figure 2, Media Database). Bulthuis shows the database in memory and the media player that manages the media items in the database (See column 7, lines 1-25). Bulthuis specifically teaches the user can access a jukebox system, such as the incorporated reference to access a database (See also Van Der Meulen column 4, lines 38-53).

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- Media collection records that include data relating to groupings of the media files (See (See also Van Der Meulen column 4, lines 38-53 and figure 3-4).
- Media records that include metadata relating to the media files (See Van Der Meulen figure 3-4 and figure 7b)
- A voiced names database that stores audio files (See Van Der Meulen column 3, lines 20-67)
- Association records that associate the audio files with data from the media collection records and metadata from the media records (See Van Der Meulen column 4, lines 25-67)

Accordingly, it would have been obvious to one of ordinary skill in the art to apply the teachings of Bulthuis to Van Der Meulen because of the explicit suggestion and incorporation by reference.

With respect to **dependent claim 22**, Bulthuis teaches the media management system wherein the media management system is executed on a portable digital music player (figure 3 and column 8, lines 1-17).

In regard to **dependent claim 26**, Bulthuis teaches a client device comprising:

- a processor a memory, operatively connected with the processor, the memory storing media content and metadata for a plurality of media items, the memory also storing audio content representing associated with the metadata for the media items (See figure 3) wherein the processor is operable to perform instructions including receiving a selection of one of the media items and then playing the audio content for at least a portion of the metadata representing associated with the selected one of the media items (See column 7, lines 5-67)
- With respect to **dependent claim 27**, Bulthuis teaches the client device wherein the processor is further operable to perform instructions including playing the media content

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for the selected one of the media items concurrently with the playing the audio content for at least the portion of the metadata associated with the selected one of the media items (See column 7, lines 5-67)

With respect to **dependent claim 28**, Bulthuis teaches the client device wherein the processor is further operable to: present a menu on the client that includes menu choices represented by the text strings, the menu choices being capable of being highlighted or selected; and play the audio file on the client when the associated menu choice is highlighted (See column 3, lines 1-67 and column 7, lines 5-67)

With respect to **dependent claim 29**, Bulthuis teaches the client device wherein the processor is further operable receiving instructions from a remote control to navigate through the menu (See column 9, lines 1-25).

Response to Arguments

Applicant's arguments are moot in light of the new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6983251 to Umemoto et al, issued Jan 3, 2006 and filed Feb. 15, 2000, that expressly teaches an audio interface with a menu that has voice activated options. The menus are loaded onto the device, and the purpose of the invention is to aid in selecting items and reading the sound information to the user. The sound information in the menu directly pertains to audio files for playing music.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven B Theriault/
Patent Examiner
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